

ESTTA Tracking number: **ESTTA229003**Filing date: **08/07/2008**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Academy of Motion Picture Arts and Sciences		
Entity	Corporation	Citizenship	California
Address	8949 Wilshire Boulevard Beverly Hills, CA 90211 UNITED STATES		

Attorney information	Ulana Holubec, Claudia Bogdanos Quinn Emanuel Urquhart Oliver & Hedges 51 Madison Ave. 22nd Floor New York, NY 10010 UNITED STATES ulanaholubec@quinnemanuel.com, claudiabogdanos@quinnemanuel.com, davidquinto@quinnemanuel.com Phone:212 849-7255
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Registration Subject to Cancellation

Registration No	3235385	Registration date	04/24/2007
Registrant	Breathe California of Sacramento-Emigrant Trails 909 12th Street Sacramento, CA 95814 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 1996/02/01 First Use In Commerce: 2003/01/01 All goods and services in the class are cancelled, namely: Promoting public awareness through youth advocacy of the issue of tobacco glamorization in film, using a program modelled after a Hollywood style awards ceremony
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Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1103859	Application Date	06/01/1977
Registration Date	10/10/1978	Foreign Priority Date	NONE
Word Mark	ACADEMY AWARDS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1928/08/00 First Use In Commerce: 1928/08/00 BOOKS, PAMPHLETS, BROCHURES AND PRESS KITS ISSUED FROM TIME TO TIME Class 041. First use: First Use: 1929/05/16 First Use In Commerce: 1953/03/19 EDUCATIONAL AND ENTERTAINMENT SERVICES RENDERED THROUGH THE MEDIUM OF AN ANNUAL LIVE, TELEVISION PROGRAM DEALING WITH MOTION PICTURES

U.S. Registration No.	1956313	Application Date	03/22/1995
Registration Date	02/13/1996	Foreign Priority Date	NONE
Word Mark	ACADEMY AWARDS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1978/00/00 First Use In Commerce: 1989/04/00 sweatshirts; jackets; T-shirts; and, caps		

U.S. Registration No.	2245965	Application Date	03/16/1998
Registration Date	05/18/1999	Foreign Priority Date	NONE
Word Mark	ACADEMY AWARD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1929/05/16 First Use In Commerce: 1953/05/19 Entertainment services, namely, an annual award program for presentation of awards in recognition of distinguished achievement in the motion picture industry; educational services, namely, providing incentives to persons to demonstrate excellence in the field of motion pictures through the issuance of awards		

Attachments	AMPAS - Cancellation Petition - THE HACKADEMY AWARDS.pdf (7 pages)(111138 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/ulanaholubec/
Name	Ulana Holubec
Date	08/07/2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 3,235,385
Registered April 24, 2007
Mark: THE HACKADEMY AWARDS

ACADEMY OF MOTION PICTURE ARTS AND
SCIENCES,

Petitioner, Cancellation No. _____

-against-

BREATHE CALIFORNIA OF SACRAMENTO-
EMIGRANT TRAILS,

Respondent.

PETITION FOR CANCELLATION

TO THE COMMISSIONER FOR TRADEMARKS:

Petitioner Academy of Motion Picture Arts and Sciences ("The Academy") believes it is, and will continue to be, damaged by the existence of Registration Number 3,235,385 for the mark THE HACKADEMY AWARDS and hereby petitions for cancellation of the same pursuant to Section 14(1) of the Trademark Act of 1946, as amended (the "Lanham Act"), 15 U.S.C. § 1064(1).

1. Petitioner The Academy is a corporation duly organized and existing under the laws of the State of California, with its principal place of business at 8949 Wilshire Boulevard, Beverly Hills, California 90211.

2. Respondent Breathe California of Sacramento-Emigrant Trails is, upon information and belief, a corporation duly organized and existing under the laws of California, with its principal place of business at 909 12th Street, Sacramento, California.

3. For many years, and long before January 1, 2003, the date of first use in commerce in Respondent's registration, and April 24, 2007, the filing date of Respondent's application, Petitioner has used the trademarks ACADEMY AWARDS and ACADEMY AWARD, and variations thereof (collectively, the "ACADEMY AWARDS Marks") in connection with its business of recognizing outstanding achievement in the motion-picture industry, and related goods and services.

4. In 1929, The Academy first bestowed its world-famous Academy Awards honors, and continues to organize the annual Academy Awards gala. Since that time, The Academy has used its ACADEMY AWARDS Marks and other marks for educational and entertainment services, library and reference services, and theatrical exhibitions of motion pictures. Over the years, the presentation of the Academy Awards honors and the anticipation and excitement leading up to the event have become tremendously popular. Each year, hundreds of millions of viewers in 200 countries and territories tune in to the television broadcast of the celebrity-studded Academy Awards ceremony and the commentary that precedes it.

5. Petitioner and its sponsors spend millions of dollars annually to advertise and promote the Academy Awards event and associated products and services through various media, including television, the internet, radio, newspapers and magazines, and other means.

6. As a result of the substantial use, advertisement, and promotion of the Academy Awards event by The Academy, as well as the international media attention and the resulting

renown of the Academy Awards ceremony, The Academy has gained very valuable goodwill and strong customer recognition worldwide in its famous ACADEMY AWARDS Marks.

7. On October 10, 1978, The Academy obtained Registration No. 1,103,859 for its ACADEMY AWARDS mark in connection with "books, pamphlets, brochures and press kits issued from time to time," in International Class 16; and "educational and entertainment services rendered through the medium of an annual live television program dealing with motion pictures," in International Class 41.

8. On February 13, 1996, The Academy obtained Registration No. 1,956,313 for its ACADEMY AWARDS mark in connection with "sweatshirts; jackets; T-shirts; and, caps," in International Class 25.

9. On May 18, 1999, The Academy obtained Registration No. 2,245,965 for its ACADEMY AWARD mark in connection with "[e]ntertainment services, namely, an annual award program for presentation of awards in recognition of distinguished achievement in the motion picture industry; educational services, namely, providing incentives to persons to demonstrate excellence in the field of motion pictures through the issuance of awards," in International Class 41.

10. All of The Academy's above-referenced trademark registrations are valid and incontestable.

11. The Academy also uses its ACADEMY AWARDS Marks on several of its websites, including <www.academyawards.com>, <www.oscar.com>, and <www.oscars.org>.

12. The ACADEMY AWARDS Marks are so widely recognized, both nationally and internationally, that they have become famous and world-renowned marks. People throughout

the world associate The ACADEMY AWARDS Marks with excellence in film, and the film industry in general.

13. Petitioner's ACADEMY AWARDS Marks were famous at least as of, and long before, January 1, 2003, the alleged date of first use in commerce of the mark sought to be cancelled herein.

14. Petitioner's ACADEMY AWARDS Marks were distinctive at least as of, and long before, January 1, 2003, the alleged date of first use in commerce of the mark sought to be cancelled herein.

15. Respondent is the current listed owner of Registration No. 3,235,385 for the designation THE HACKADEMY AWARDS in connection with "[p]romoting public awareness through youth advocacy of the issue of tobacco glamorization in film, using a program modelled after a Hollywood style awards ceremony," in International Class 35.

16. Respondent filed its application for the registration sought to be cancelled herein on February 28, 2006. Petitioner has decades of priority over Respondent's THE HACKADEMY AWARDS mark.

17. The similarity of Respondent's mark to Petitioner's ACADEMY AWARDS Marks is evidenced by, *inter alia*, Respondent's explicit intent to mimic Petitioner's marks, expressed by Respondent in the identification of services in its trademark registration.

18. Petitioner is, and will continue to be, damaged by the existence of Registration No. 3,235,385, because said registration is so deceptively similar to The Academy's famous ACADEMY AWARDS Marks as to dilute the ACADEMY AWARDS Marks and harm the

reputation of the Academy, and to cause likely confusion to the public as to the origin or affiliation of Respondent's services.

19. Cancellation of Respondent's mark should be granted pursuant to Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), on the grounds that Petitioner is, and will continue to be, damaged by said registration because the registration dilutes the distinctive and famous quality of Petitioner's ACADEMY AWARDS Marks.

20. Cancellation of Respondent's mark should be granted pursuant to Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), on the grounds that Respondent's use of said registration falsely suggests a connection between Respondent and Petitioner, to the damage of Petitioner.

21. Cancellation of Respondent's mark should be granted pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the grounds that said registration so resembles Petitioner's ACADEMY AWARDS Marks used consistently by Petitioner in the United States, as to be likely, when used on or in connection with the goods and services identified in the registration, to cause confusion, or to cause mistake, or to deceive, with consequent injury to Petitioner and to the public.

WHEREFORE, Petitioner respectfully requests that this Petition for Cancellation be sustained and that Registration No. 3,235,385 be cancelled.

Pursuant to 37 C.F.R. § 2.6(a)(16), please charge Deposit Account Number 50-3778 the requisite amount of three hundred dollars (\$300.00) to cover the statutory fee for filing a petition for cancellation in one International Class. Please also charge any additional amounts to Deposit Account Number 50-3778.

Respectfully submitted,

Dated: August 7, 2008

By: 

QUINN EMANUEL URQUHART
OLIVER & HEDGES, LLP
Claudia T. Bogdanos
Ulana Holubec
51 Madison Avenue, 22nd Floor
New York, NY 10010
Telephone: (212) 849-7255
Facsimile: (212) 849-7100

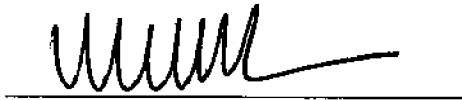
QUINN EMANUEL URQUHART
OLIVER & HEDGES, LLP
David W. Quinto
865 South Figueroa Street, 10th Floor
Los Angeles, CA 90017-2543
Telephone: (213) 443-3000
Facsimile: (213) 443-3100

*Attorneys for Petitioner Academy of Motion
Picture Arts and Sciences*

CERTIFICATE OF SERVICE

I certify that on the 7th day of August, 2008, I caused a true copy of the attached Petition for Cancellation to be served on Registrant Breathe California of Sacramento-Emigrant Trails, by sending same via overnight mail to Registrant's counsel, Lezlie Jensen-Huston, at the following address:

Cobalt LLP
819 Bancroft Way
Berkeley, CA 94710

A handwritten signature in black ink, consisting of several loops and a long horizontal stroke at the end, positioned above a solid horizontal line.

Ulana Holubec